

REMARKS

Claims 1-6, 8-24, and 26-34 and newly added Claims 35-37 are currently pending. Applicants note that all amendments of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended Claims (or similar Claims) in the future.

In the present Office Action, the Examiner rejected Claims 1-6, 8-24 and 26-34 under 35 U.S.C. § 103 as allegedly being obvious in light of Chong et al. (Rapid Commun. Mass Spectrometr 12:1986 [1998]); hereinafter Chong) in view of Richmond et al (Richmond et al., J. Chromatography 835:29 [1999]; hereinafter Richmond).

In the Office Action dated October 1, 2003, the Examiner indicated that several references filed in the Information Disclosure Statement filed June 26, 2003 were not considered because the references were not provided (Office Action, pg. 4). The Applicants have provided a Supplemental Information Disclosure Statement (attached herewith) containing references that the Examiner did not consider.

I. The Claims are not obvious

Claims 1-6, 8-24 and 26-34 stand rejected under 35 U.S.C. § 103 as allegedly being obvious in light of Chong and Richmond (Office Action, pg. 2). The Applicants respectfully disagree. The Applicants submit that the examiner has failed to provide a *prima facie* case of obviousness. The combination of references referred to by the Examiner fails to provide a *prima facie* showing of obviousness as required by § 2143 of the Manual of Patent Examining Procedure (MPEP). There are three criteria which must be met to provide *prima facie* obviousness. The first of these criteria is a suggestion or motivation in the references or the knowledge generally available to combine the reference teachings. The second criteria is that the prior art must teach or suggest all the claim limitations. The third criteria is a reasonable expectation of success should the combination be carried out.

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

Applicants submit that the Examiner has failed to set forth a *prima facie* case of obviousness because none of the three criteria have been met. In particular, the Applicants submit that the Examiner has pointed to no teaching in either Chong or Richmond to combine the references to arrive at the presently claimed invention. For example, Richmond provides no teaching that the display methods that Richmond applies to chemical samples be used in the display of protein samples, let alone multiple protein samples. Furthermore, Chong does not suggest the need for an alternate display method (*i.e.*, there is no basis in Chong or Richmond that would lead one to even contemplate modification of Chong as suggested by the Examiner). The applicants submit that the Examiner has instead applied improper hindsight reconstruction. Applicants submit that the case law is clear that any teaching or suggestion to combine or modify references must be found in the reference(s) themselves or in the knowledge available to one of ordinary skill in the art. They may not, as the Examiner has attempted to do, be derived from the applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Furthermore, the purpose of this requirement is to prevent the Examiner from using the invention itself and hindsight reconstruction to defeat the patentability of the invention (*In re Rouffet et al.*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998)). The Examiner is reminded, that under the law, an Examiner is not one skilled in the art and that consequently, the Examiner's opinion as to what one skilled in the art might believe is not sufficient support for a motivation to modify the teachings of the cited reference (See, *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993)). The suggestion to combine prior art references must come from the cited references, not from the applicant's disclosure.² The Examiner's rejection does not establish the requisite suggestion in the art to combine elements disclosed in the prior art. "A rejection cannot be predicated on the mere identification . . . of individual components of claimed limitations. Rather, particular findings must be made as to the reasons the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."³ The need for a specific suggestion in the cited references is absolute: "The factual inquiry whether to combine references must be thorough and searching. It must be based on **objective evidence of record**. This precedent has been reinforced in myriad decisions and

² *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1998)

³ *Ecolchem*, 227 F.3d, 1361, 1375, 56 USPQ2d 1065, 1076, quoting *Kotzab*, 217 F.3d 1365, 1371,

cannot be dispensed with.”⁴ (Emphasis added).

The Applicants further submit that even if Chong and Richmond are improperly combined, they do not teach all of the elements of the presently claimed invention. In particular, neither Chong nor Richmond, alone or in combination, teach the claim element of a protein profile map that displays protein abundance and mass of a separated protein sample.

Furthermore, the Examiner has pointed to no teaching in Chong or Richmond, alone or in combination, of the elements of dependent claims 13 or 21. For example, the Examiner has pointed to no teaching (nor is any present) in Chong or Richmond of the claim element of a switchable, multichannel valve (Claims 13 and 33) or the use of Esi oa TOF mass spectroscopy (Claims 21 and 34) with the methods of the presently claimed invention. As such, these claims should be allowed.

The Applicants submit that the claims are not obvious. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended independent claims 1, 23, and 28 to include the step of displaying protein profile maps corresponding to each of the protein samples side by side. Support for this amendment can be found, for example, in Figures 3 and 5. Neither Chong nor Richmond, even if the teachings of the two references are improperly combined, provide a teaching of a side by side display showing both protein mass and abundance of multiple samples. As such, the Applicants submit that the claims are not obvious. As such, the Applicants respectfully request that the rejection be withdrawn.

II. New Claims 35-37 are not Obvious

The Applicants have added new Claims 35-37. The new claims are directed towards differential display methods. Support for the new claims can be found in the specification (pg. 20, lines 1-7). As neither Chong nor Richmond, alone or in combination, teach differential display methods, the Applicants submit that Claims 35-37 should be allowed.

⁴ 55 USPQ2d 1313, 1317.

In Re Sang Su Lee, 277 F.3d 1338, 1341, USPQ2d 1430, 1433.

CONCLUSION

All grounds of rejection and objection of the Office Action of April 8, 2003, having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the Claims should be allowed. Should the Examiner have any questions, or if a telephone conference would aid in the prosecution of the present application, Applicants encourage the Examiner to call the undersigned collect at 608-218-6900.

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